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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/013,056	10/30/2001	Tanja Ligensa	9525	1464
151	7590	02/12/2004	EXAMINER	
HOFFMANN-LA ROCHE INC. PATENT LAW DEPARTMENT 340 KINGSLAND STREET NUTLEY, NJ 07110			ANDRES, JANET L	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/013,056	Applicant(s) LIGENSA ET AL.	
	Examiner Janet L. Andres	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>sequence alignment</u> . |

RESPONSE TO AMENDMENT

1. Applicant's amendment filed 24 November 2003 is acknowledged. Claims 1, 2, and 4-6 are pending and under examination in this office action. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

Claim Rejections/Objections Withdrawn

2. Applicant's comments with respect to the priority claim having been noted are acknowledged and the objection to the specification is withdrawn.
3. The rejection of claims 1-3 as being drawn to non-statutory subject matter is withdrawn in response to Applicant's cancellation of claim 3 and amendment requiring that the nucleic acids of claims 1 and 2 be isolated.
4. The rejection of claims 1 and 2 as indefinite is withdrawn in response to Applicant's amendment removing the hybridization language from claim 1 and correcting the reference to SEQ ID NO: 2 in claim 2.
5. The rejection of claims 1, 3, 5, and 6 under 35 U.S.C. 102(b) as being anticipated by Rousset et al. is withdrawn in response to Applicant's amendment removing the hybridization language from claim 1.

Claim Rejections Maintained/New Grounds of Rejection

6. The rejection of claims 1, 3, 5, and 6 under 35 U.S.C. 102(b) as being anticipated by De Vries et al. is maintained for reasons of record in the office action of 25 June 2003 and newly applied to claims 2 and 4.

Applicant's amendment fails to overcome this rejection because the polynucleotide taught by De Vries encodes a polypeptide encompassed by Applicant's SEQ ID NO: 2. SEQ ID

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NO: 2 contains three undefined amino acids. The sequence of De Vries encodes a polypeptide identical to every specified residue of SEQ ID NO: 2 and thus anticipates Applicant's more generic sequence. See alignment provided. Claims 2 and 4 were inadvertently omitted from the previous rejection.

7. Claims 5 and 6 are newly rejected under 35 U.S.C. 101 as being drawn to non-statutory subject matter. Because they do not require that the host cells be isolated, they encompass cloned humans.

NO CLAIM IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (571) 272-0867. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (571) 272-0871. The fax phone number for this group is (703) 872-9306. Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to yvonne.eyler@uspto.gov.

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

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NO: 2 contains three undefined amino acids. The sequence of De Vries encodes a polypeptide identical to every specified residue of SEQ ID NO: 2 and thus anticipates Applicant's more generic sequence. See alignment provided. Claim 4 was inadvertently omitted from the previous rejection.

7. Claims 5 and 6 are newly rejected under 35 U.S.C. 101 as being drawn to non-statutory subject matter. Because they do not require that the host cells be isolated, they encompass cloned humans.

NO CLAIM IS ALLOWED.

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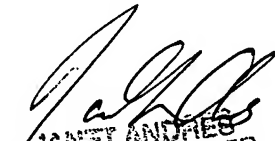
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set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.

February 9, 2004



JANET ANDRES
PATENT EXAMINER